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09/661,739	09/14/2000	Jeffrey D. Ollis	D-2340	9031

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Wendy W Koba Esq  
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EXAMINER

KAPADIA, MILAN S

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 06/02/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/661,739

Applicant(s)

OLLIS, JEFFREY D.

Examiner

Milan S Kapadia

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

*Notice to Applicant*

1. This communication is in response to the amendment filed 17 March 2004. Claims 1-12 are pending. Claims 1, 6, 7, 9, 10, and 12 have been amended. Claim 13 is newly added.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krane (5,799,063) in view of Fung et al. (6,069,939).

(A) As per claim 1, Krane teaches a system for providing, locally generated prompts/announcements in a telecommunications network, the system comprising a centralized service for storing a plurality of prompt/announcement files, said plurality including various types of files (Krane; abstract and col. 3, lines 28-42; the Examiner interprets the "Web site server" as the "centralized service");

a telecommunications device located in close proximity to the user, said telecommunications device for downloading predetermined subset files from said plurality of files (Krane; col. 3, lines 28-57; the Examiner interprets the “web access server” as the “telecommunications device”; and

at least one communication device for interacting with said telecommunications device and selecting the predetermined subset of files from said plurality of files to be downloaded (Krane; col. 3, lines 28-57 and figure 1; the Examiner interprets the “telephone” as the “communications device.”)

Krane fails to expressly teach wherein said plurality of files are organized in a system with respect to user characteristics and downloading a predetermined subset of files associated with said user characteristics from said plurality of files. However, this feature is old and well known in the art, as evidenced by Fung’s teachings with regards to wherein said plurality of files are organized in a system with respect to user characteristics and downloading a predetermined subset of files associated with said user characteristics from said plurality of files (Fung; abstract and col. 6, lines 9-23). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Krane with Fung’s teaching with regards to this limitation, with the motivation of increasing the ease with the receiver of the files can overcome language difficulties (Sparks; col. 2, lines 46-50).

(B) As per claim 2, Krane teaches wherein the at least one communication device comprises a telephone with a keypad for selecting prompt/announcement files (Krane; figure 1).

(C) As per claim 3, Krane teaches wherein the selected prompt/announcement files comprise voice files (Krane; abstract).

(D) As per claim 13 Krane fails to expressly teach wherein the user characteristics include the user's language, location and subscribed-to telecommunication services. However, this feature is old and well known in the art, as evidenced by Fung's teachings with regards to wherein the user characteristics include the user's language, location and subscribed-to telecommunication services (Fung; abstract, col. 2, lines 55-65, col. 3, lines 28-30 and col. 5, lines 27-31). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Krane with Fung's teaching with regards to this limitation, with the motivation of increasing the ease with the receiver of the files can overcome language difficulties (Sparks; col. 2, lines 46-50).

4. Claims 4-7 9, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krane (5,799,063) and Fung et al. (6,069,939) as applied to claim 1 above and further in view of Sparks et al. (6,222,838).

(A) As per claims 4 and 6, the combined system of Krane and Fung collectively fail to expressly teach wherein the at least one communication device comprises a computer with a keyboard for selecting prompt/announcement files and wherein the at least one communication

Art Unit: 2144

device comprises a telephone with a keyboard for selecting a first group of files and a computer with a keyboard for selecting a second group of files. However, this feature is old and well known in the art, as evidenced by Spark's teachings with regards to wherein the at least one communication device comprises a computer with a keyboard for selecting prompt/announcement files and wherein the at least one communication device comprises a telephone with a keyboard for selecting a first group of files and a computer with a keyboard for selecting a second group of files (Sparks; col.3, line 3-col. 4, line 18). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Krane and Fung with Spark's teaching with regards to this limitation, with the motivation of reducing the strain of network resources by enabling the delivering of audio and data files to a user over common and independent networks (Sparks; col. 1, lines 57-62).

(B) As per claim 5, the combined system Krane and Fung collectively fail to expressly teach wherein the selected files are chosen from a group consisting of text files, video files and multimedia files. However, this feature is old and well known in the art, as evidenced by Spark's teachings with regards to wherein the selected files are chosen from a group consisting of text files, video files and multimedia files (Sparks; col.4, lines 41-67). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Krane and Fung with Spark's teaching with regards to this limitation, with the motivation of reducing the strain of network resources by

Art Unit: 2144

enabling the delivering of audio and data files to a user over common and independent networks (Sparks; col. 1, lines 57-62).

(C) As per claim 7, the combined system of Krane and Fung collectively fail to expressly teach wherein the first group of files comprises voice files and the group subset of files comprises files chosen from a group consisting of text files, video files and multimedia files. However, this feature is old and well known in the art, as evidenced by Spark's teachings with regards to wherein the first group of files comprises voice files and the second group of files comprises files chosen from a group consisting of text files, video files and multimedia files (Sparks; col. 3, lines 35-44 and col.4, lines 41-67). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Krane and Fung with Spark's teaching with regards to this limitation, with the motivation of reducing the strain of network resources by enabling the delivering of audio and data files to a user over common and independent networks (Sparks; col. 1, lines 57-62).

(D) As per claim 9, Krane fails to expressly teach the features of claim 9. However, this feature is old and well known in the art, as evidenced by Fung's teachings with regards to a method of providing client-side prompt/announcement files for use by a subscriber on a local telecommunications device from a plurality of prompt/announcement files stored on a centralized server (Fung; abstract and col. 3, lines 8-26), the method comprising the steps of : a) determining subscriber-specific characteristics (Fung; col. 2, lines 58-60) and c) downloading a

subset of prompt/announcement files from the centralized server to the local telecommunications device based upon the determined subscriber-specific characteristics (Fung; col. 2, lines 59-65).

It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Krane with Fung's teaching with regards to this limitation, with the motivation of increasing the ease with the receiver of the files can overcome language difficulties (Sparks; col. 2, lines 46-50).

The combined system of Krane and Fung collectively fail to expressly teach b) determining the type of user entry device and c) downloading a subset of prompt/announcement files from the centralized server to the local telecommunications device based upon the type of user entry device. However, this feature is old and well known in the art, as evidenced by Spark's teachings with regards to b) determining the type of user entry device (Sparks; col. 3, lines 4-33) and c) downloading a subset of prompt/announcement files from the centralized server to the local telecommunications device based upon the type of user entry device (Sparks; col. 3, lines 4-33). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Krane and Fung with Spark's teaching with regards to this limitation, with the motivation of reducing the strain of network resources by enabling the delivering of audio and data files to a user over common and independent networks (Sparks; col. 1, lines 57-62).

(E) Claims 11 and 12 repeat the features of claims 3 and 5, respectively, and are therefore rejected for the same reasons given above in the rejections of claims 3 and 5 and incorporated herein.



5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krane (5,799,063) and Fung et al. (6,069,939) as applied to claim 1 above and further in view of Akatsu et al. (6,505,255).

(A) As per claim 8, the combined system Krane and Fung collectively fail to expressly teach wherein the network comprises an HFC network and the telecommunications device comprises a communications gateway. However, this feature is old and well known in the art, as evidenced by Akatsu's teachings with regards to wherein the network comprises an HFC network and the telecommunications device comprises a communications gateway (Akatsu; col. 6, lines 41-54 and col. 7, lines 25-37). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Krane and Fung with Akatsu's teaching with regards to this limitation, with the motivation of using commonly available networking technology for delivering voice, telephony, data, and other interactive services.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krane (5,799,063), Fung et al. (6,069,939) and Sparks et al. (6,222,838) as applied to claim 9 above and further in view of Osder et al. (6,058,166).

(A) As per claim 10, the combined system of Krane, Fung and Sparks collectively teach the subscriber-specific characteristics include location and subscribed-to telecommunication services

Art Unit: 2144

(Krane; col. 5, lines 18-37) but collectively fail to expressly teach the subscriber characteristics include language. However, this feature is old and well known in the art, as evidenced by Osder's teachings with regards to the subscriber characteristics include language (Osder; abstract). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the collective system taught by Krane, Fung and Sparks with Osder's teaching with regards to this limitation, with the motivation of downloading the subset or prompts/files based on the desired language (Osder; abstract).

***Response to Arguments***

7. Applicant's arguments with respect to amended claims 1-12 and new claim 13 have been considered but are moot in view of the new ground(s) of rejection.

(A) At page 5-8 of the 3/17/04 communication, Applicant argues each of the applied references individually. In response, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In particular, the teachings that Applicant argues are missing from the Krane, Spark, Akatsu and/or Osder references are clearly disclosed in the respective teachings of Fung, when considered collectively with that of Krane, Spark, Akatsu and/or Osder, as discussed in detail within a prior Office Action (paper number 4) and in the preceding rejections, and incorporated herein.

Further, the features newly added and entered in the amendment filed 3/17/04, have been shown to be fully disclosed by or obvious in view of the collective teachings of Krane, Fung, Spark, Akatsu and/or Osder, as discussed above in detail within the preceding sections of the present Office Action.

In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

#### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
mk

MARC D. THOMPSON  
  
PRIMARY EXAMINER

May 27, 2004